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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/715,869	09/19/96	HEPPLER	S 2972US(92-04

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PM82/0509

EXAMINER

NGUYEN, T

ART UNIT	PAPER NUMBER
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3653

*24*

DATE MAILED:

05/09/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/715,869

Applicant(s)

Steve Heppler

Examiner

Tuan Nguyen

Group Art Unit

3653

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE three (3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 4/16/01.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-13, 16, 19, 22, 25-27 and 29-31 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☒ Claim(s) 1-6, 13, 16, 19, 22, 27 and 31 is/are allowed.
- ☒ Claim(s) 7-12, 25, 26, 29 and 30 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☒ The proposed drawing correction, filed on Oct. 8, 1998 is ☒ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_.

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

Art Unit: 3653

### DETAILED ACTION

1. After further reconsideration, the final rejection mailed on December 15, 2001 (paper no. 21) is hereby withdrawn.

2. Claims 7-12, 25, 26, 29 and 30 are rejected under 35 U.S.C. 251 as being improperly broadened in a reissue application made and sworn to by the assignee and not the patentee.

Applicant had admitted in the declaration that independent claims 7, 10, 25 and 29 are broadened from the patented claims 1-6 in Patent No. 5,348,164.

Claims 7-12, 25, 26, 29 and 30 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Art Unit: 3653

The reasons for improper recapture are: In the reissue application, independent claims 7, 10, 25 and 29 do not include the allowable subject matters "a first track....." and "a second track....." as cited in independent claim 1 of Patent No. 5,348,164.

3. Claims 1-6, 13, 16, 19, 22, 27 and 31 are allowed.

4. Applicant's arguments filed on April 16, 2001 have been fully considered but they are not persuasive.

Responding to applicant's remarks, applicant has argued that independent claims 7 and 10 are narrower than independent claim 1 of Patent No. 5,348,164 (Patent' 164). However, the Examiner respectfully disagrees. Claims 7 and 10 do not further have limitations "a first track for receiving the integrated circuit from the holding station when the holding station is in the first test position" and "a second track for receiving the integrated circuit.....when said receiving means returns to said test position" as cited in paragraphs (d) and (e) of claim 1 in Patent' 164. Regarding claims 25 and 29, "a first track" and "a second track" still lack further limitations as cited above.

5. Any inquiry concerning this communication should be directed to Examiner Tuan Nguyen at telephone number (703) 308-3664.

tnn,

May 04, 2001.



TUAN N. NGUYEN  
PRIMARY EXAMINER

5/4/01